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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,810	02/19/2004	Robert Eugene Hormann	A01494-US	7816

7590 12/29/2006
Rheo Gene INC.
2650 Eisenhower Avenue
Norristown, PA 19403

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/783,810

Applicant(s)

HORMANN ET AL.

Examiner

Laura L. Stockton, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/20/2006</u> | 6) <input type="checkbox"/> Other: _____ |

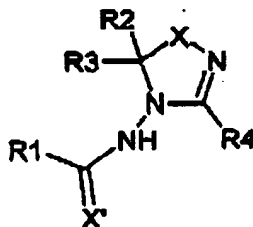
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DETAILED ACTION

Claims 1-17 are pending in the application.

Election/Restrictions

Applicant's election with traverse of Group I
(Claims 1-5), and the species wherein



wherein X = O

R¹ = 2-fluoro-4-ethylphenyl;

R², R³ = -(CH₂)₄; and

R⁴ = 3,5-dimethylphenyl.

(which is Compound RG-121515 found on page 15 of the instant specification), in the reply filed on November 29, 2006 is acknowledged. The traversal is on the ground(s) that: (1) the search and examination of the entire application can be made without serious burden on the Examiner (2) the groups designated by the

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Examiner fail to define products with properties so distinct as to warrant separate examination and search; and (3) withdrawal of the Requirement for Restriction of Groups I and III is believed to be in order.

This is not found persuasive because, noted in the Restriction Requirement, separate search considerations are involved for each of the outlined groups. Also note the different subclass searches for the products of Groups I and Group II as well as the differing class searches for Groups III-V. Therefore, it would impose an undue burden on the Examiner and the Patent Office's resources if the instant application were unrestricted.

Additionally, in accordance with M.P.E.P. §821.04 and In re Ochiai, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper.

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Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

The requirement is still deemed proper and is therefore made FINAL.

Subject matter not embraced by elected Group I and Claims 6-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 29, 2006.

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It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statement filed on January 20, 2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hussein et al. {Heterocycles, (1994), 38(5), pages 981-990}.

Hussein et al. disclose the compound of Entry 3d on page 982, which is embraced by the instant claimed invention. Therefore, Hussein et al. anticipate the instant claimed invention.

Allowable Subject Matter

The elected species of Compound RG-121515, found on page 15 of the instant specification, is allowable over the art of record.

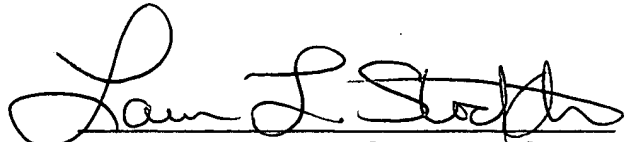
Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", is written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

December 26, 2006